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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/837,755 Confirmation No. : 2048
First Named Inventor : Iris ZIEGLER
Filed : May 4, 2004
TC/A.U. : 1609
Examiner : A. Sasan

Docket No. : 029310.50932D1
Customer No. : 23911

Title : Sustained-release, oral pharmaceutical formulations and methods of making and using same

REPLY TO OFFICE ACTION

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply to the Office Action mailed January 23, 2007 in the above-identified patent application.

Responsive to the requirement for restriction, Applicants hereby provisionally elect the claims of Group I, namely, pharmaceutical formulation claims 1-19. This provisional election is made with traverse.

The restriction requirement is respectfully traversed because the basis upon which the requirement is based is erroneous.

For example, the restriction between the product claims 1-19 and process claim 20 is assertedly justified on grounds the process for using the product **as claimed** can be practiced with another materially different product because "the process of using the composition for treating pain can be practiced with other materially different products such as compositions of analgesics in tablets or capsules." This is incorrect because the process **as claimed** is not merely the treatment of pain. Instead the process **as claimed** requires the use of the product recited in the claims. Although it is surely possible to use products outside the scope of the claims to treat pain, it is error to equate the use of such products outside the scope of the claim with the process **as claimed**.

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Similarly, restriction between the product claims 1-19 and method of making claims 21 and 22 is assertedly justified on grounds the process **as claimed** can be used to make another and materially different product because "the process of preparing the sustained release composition can be used to prepare materially different products with mixtures of different active pharmaceutical ingredients and acidic substances." This again is incorrect because the process **as claimed** requires the use of the ingredients recited in the claims, and application of the process steps to these ingredients will necessarily result in the claimed product. Although analogous process steps could be applied to other ingredients outside the scope of the claims, it is error to equate formulation of ingredients outside the scope of the claim with the process **as claimed**.

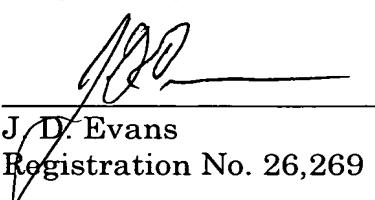
It follows that the restriction requirement is based on erroneous premises and cannot be sustained. Reconsideration and withdrawal thereof are accordingly respectfully requested.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 029310.50932D1).

Respectfully submitted,

February 23, 2007


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